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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/734,331	11/30/2000	Kurt B. Schurenberg	5435-19800	3825
20583	7590	03/30/2004	EXAMINER	
JONES DAY 222 EAST 41ST STREET NEW YORK, NY 10017			KOPPIKAR, VIVEK D	
			ART UNIT	PAPER NUMBER

3626

DATE MAILED: 03/30/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/734,331

Applicant(s)

SCHURENBERG ET AL.

Examiner

Vivek D Koppikar

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 30 November 2000.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-4 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-4 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 25 May 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date Z.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## DETAILED ACTION

### *Status of Case*

1. This communication is in response to the application filed on November 30, 2000 which claims domestic priority to a provisional application filed on December 1, 1999. Claims 1-4 are pending in the case and have been examined. The Information Disclosure Statement filed on August 29, 2001 has been acknowledged.

### *Specification*

2. Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

The abstract of the disclosure is objected to because the abstract exceeds 150 words in length. Correction is required. See MPEP § 608.01(b).

### *Claim Objections*

4. Claim 2 is objected to because of the following informalities: The word "sendinf" in line 3 should be "sending". Appropriate correction is requested and required.

*Claim Rejections - 35 USC § 102*

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 1 and 3-4 are rejected under 35 U.S.C. 102(b) as being anticipated by US Patent Number 5,823,948 to Ross, Jr. et al.

Ross is directed towards a medical records, documentation, tracking and order entry system.

As per claim 1, Ross teaches a lab module within the medical records tracking system which allows a user to generate orders for certain lab tests. The program is stored on a server and executed on a client application. Once the lab tests are completed they are electronically sent back to the TeleMed system (an electronic modem-based communication system) where the user can access the results (Figure 1, Figures 4-5, Col. 9, Ln. 43-53 and Col. 10, Ln. 10-27).

As per claim 3, in one embodiment, the user can order tests from more than one lab (116) (Figure 4) and the labs send these results back to the user of the system.

As per claim 4, the lab test order system is executed on a client system but interfaces with a middleware server (Ross refers to the middleware server as an "Interface to Other System" (Figure 1)).

7. Claims 1 and 3 are rejected under 35 U.S.C. 102(b) as being anticipated by [www.abaton.com](http://www.abaton.com) (published on April 23, 1998).

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Abaton.com is a website dedicated to linking physicians between their primary trading partners (labs, pharmacies, health care payers, etc.). Abaton.com includes a system known as POLAR (Physician Online Laboratory Reporter).

As per claims 1 and 3, the POLAR system provides an application for physicians in order to enable them to electronically order laboratory tests and receive the results (Page 3, Paragraph 2).

***Claim Rejections - 35 USC § 103***

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Ross as applied to Claim 1 above and in further view of US Patent Number 6,216,112 to Fuller.

Ross fails to teach a feature in the medical records tracking system which allows a user to store a request on a local computer and send the stored request to the laboratory's server at a later time; however this feature is well known in the art as evidenced by Fuller.

Fuller teaches the concept of storing data on a client system and transmitting the data to a server at a later time (Col. 16, Ln. 45-64). It would have been obvious at the time of the invention for one of ordinary skill in the art to have included this feature in the medical records tracking system of Ross with the motivation of providing a means to store requisition data for transmission to the laboratory's server at a later time in the instance that the laboratory's server was overloaded or busy at the time the user made the original requisition.

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***Conclusion***

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

"Online transmission of lab tests mostly a one-way trip" describes various Internet based system which enable physicians to order and receive laboratory tests online.

www.axolotl.com is a printout of a website which allows for more enhanced clinical communication between independent providers and their healthcare partners.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Vivek Koppikar** whose telephone number is **(703) 305-5356**. The examiner can normally be reached on Monday-Friday from 8 AM to 5 PM, Eastern Time.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Thomas, whose phone number is (703) 305-9588. The fax phone number for the organization where this application or proceeding is assigned are (703) 872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Vivek Koppikar

3/22/04



JOSEPH THOMAS  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 3600